

REMARKS

Reconsideration and allowance of this application are respectfully requested. New claims 26-28 have been added. Claims 1-28 are now pending in the application. The rejections are respectfully submitted to be obviated in view of the remarks presented herein.

Rejection Under 35 U.S.C. § 102(a) - Emmott et al.

Claims 1, 3, 8-11, 20 and 25 have been rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Emmott et al. (EP 0,965,938 A2; hereinafter "Emmott"). The rejection is respectfully traversed.

Regarding claim 1, Applicant's claimed invention relates to a portable terminal storing and accessing secret data. A control section is connected to a signal transfer line set provided between a storage device and a system unit. The control section validates transfer of a control signal, transferred from the storage device to the system unit or from the system unit to the storage device on the signal transfer line set, to permit the transfer of the secret data.

Turning to the cited art, Emmott discloses a portable communication device which modifies a monetary amount stored in a smart card, as shown in Figures 1 and 3. A user does not gain access to the data communications network until a match is detected of an authorized user through a biometric recognition device (14), upon which time access to data stored in the smart card is freely given. The biometric recognition device (14), an iris recognition device, enables a transaction processor (20) upon detecting a match, and otherwise shuts down the transaction processor (20) when there is no match (column 3, lines 29-33). A smart card (23) inserted in a smart card reader (18) communicates via a data bus (30) with the transaction processor (20) to

transfer data from the smart card (23) to a RAM (31) (column 3, lines 51-55). The smart card reader (18) is selectively operable and incorporates a switch (25) engageable by the user (column 1, lines 50-51). The data in the RAM (31) includes encrypted information which is accessed by the transaction processor (20) and is subject to decryption by means of a decryption program stored in a ROM (20a) (column 3, lines 55-58). The decrypted information includes financial information stored in the smart card (23), and is displayed to the user on a screen (12) (column 4, lines 1-5).

Applicant respectfully submits that the disclosure of Emmott does not anticipate the claimed invention. Emmott solely enables the transaction processor (20) upon detection of an authorized user through the recognition device (14), whereupon data may be accessed or manipulated freely. After user validation, the transaction processor (20) of Emmott is enabled, and data is transferred non-discretionally from the smart card (23) to the RAM (31), and the data is decrypted for display on the screen (12). However, Emmott does not teach or suggest a control section validating transfer of a control signal on the data bus to permit the transfer of the encrypted information. There is no validation in Emmott of transfer of a control signal to permit the transfer of secret data, instead, Emmott only enables the transaction processor (20) upon user validation, after which secret data transfer is freely requested and performed.

Examiner has relied upon a switch (25) of Emmott as part of a control section which validates transfer of a control signal from the storage device on the signal transfer line set to permit the transfer of secret data, and contends that the switch (25) allows data transfer between the storage device and the system unit on the data bus (Office Action, paragraph 27). However,

the switch (25) is only operable to turn on the card reader by pressing the smart card to engage the switch (25) (column 2, lines 38-42; see also “overlay the switch 25,” column 2, lines 52-55).

“The choice of smart card reader is made by the user by pressing a smart card to active the corresponding switch 25,” (column 4, lines 46-48). Thus, the switch (25) is only operable for choosing the desired smart card reader by engaging the switch (25) with a smart card (23) (column 3, lines 48-51). Although the smart card communicates via the data bus (30) with the transaction processor (20) to signal the selection of the chosen smart card (23) and to transfer data from the smart card (23) to the RAM (31) under the control of the transaction processor (20), the engaging of the switch (25) operation only powers up the components of the system, and the switch (25) is only operable to turn on a desired smart card reader (18) to initialize the device. The turning on of the smart card reader (18) is not a validation of transfer of a control signal as recited in Applicant’s claim. The data transferred from the smart card (23) to the RAM (31) is uninhibited after the smart card reader (18) is turned on and an authorized user is detected. None of the transfers controlled by the transaction processor (20) in Emmott are validated (column 4, lines 6-36), as Emmott discloses that complete access to the communications network has already been granted once the transaction processor (20) is enabled, and all transfers of data are allowed without validation. Thus, there is no validation of a transfer of a control signal in Emmott, either during initial authorization of a user or during transfers of data controlled by the transaction processor (20).

At least by virtue of the aforementioned differences, Applicant’s claim 1 distinguishes over Emmott. Applicant’s claims 2, 3 and 8-11 are dependent claims including all of the

limitations of independent claim 1, which, as established above, distinguishes over Emmott. Therefore, claims 2, 3 and 8-11 are distinguished over Emmott for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(a) are respectfully requested.

With further regard to claim 8, claim 8 recites that the control section comprises a switch section which generates a valid signal in response to operation of the switch section by a user, and a control circuit which operates to permit transfer of the control signal in response to the valid signal such that the transfer of the secret data is permitted. There is no teaching or suggestion in Emmott of a control section as Applicant claims. Emmott's switch (25) does not generate a valid signal, nor does any control circuit in Emmott permit transfer of a control signal in response to the valid signal to thus permit transfer of secret data. Therefore, at least by virtue of these additional differences as well as the aforementioned differences, Applicant's claimed invention distinguishes over Emmott.

Regarding claim 20, a control circuit operates to permit transfer of a control signal transferred from a system unit to a storage device, in response to a valid signal generated from a switch section, to permit the transfer of secret data from the storage device to the system unit. Emmott, as discussed above, only enables the transaction processor (20) upon user validation, after which secret data transfer is freely requested and performed. Emmott does not teach or suggest a control circuit operating to permit transfer of a control signal in response to a valid signal such that transfer of secret data is permitted. Emmott only enables the transaction processor (20) through biometric recognition, and does not at all disclose a control signal which

AMENDMENT UNDER 37 UNDER C.F.R. § 1.116
U.S. Application No. 09/810,220
Attorney Docket No. Q63638

is output to a storage device (e.g. smart card 23) by a system unit (e.g. transaction processor 20).

Also, Emmott's switch (25) operates only to select a desired smart card reader (18), and does not generate a valid signal, nor does switch (25) operate to permit transfer of a control signal in response to a valid signal such that transfer of secret data is permitted. At least by virtue of the aforementioned differences, Applicant's claim 20 distinguishes over Emmott. Applicant's claim 25 is a dependent claim including all of the limitations of independent claim 20, which, as established above, distinguishes over Emmott. Therefore, claim 25 is distinguished over Emmott for at least the aforementioned reasons as well as for its additionally recited features.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(a) are respectfully requested.

With further regard to claim 25, claim 25 recites that the switch section generates an invalid signal when the switch section is not operated, and the control circuit operates to inhibit the transfer of the control signal in response to the invalid signal such that the transfer of secret data is inhibited. There is no teaching or suggestion in Emmott of generating an invalid signal and inhibiting transfer of secret data as Applicant claims. Emmott's switch (25) does not generate an invalid signal, nor does any control circuit in Emmott inhibit transfer of a control signal in response to the invalid signal to thus inhibit transfer of secret data. Therefore, at least by virtue of these additional differences as well as the aforementioned differences, Applicant's claimed invention distinguishes over Emmott.

Rejection Under 35 U.S.C. § 103(a) - Emmott et al. in view of Nakamura et al.

Claims 4, 5, 13, 14, 17-19, 21 and 22 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Emmott in view of Nakamura et al. (U.S. Patent Number 5,917,168, "Nakamura"). The rejection is respectfully traversed.

Regarding claims 4 and 5, which are dependent on independent claim 1, Emmott fails to teach or suggest at least a control section validating transfer of a control signal on the data bus to permit the transfer of the encrypted information, as discussed above. Nakamura does not remedy the deficiencies of Emmott. Nakamura teaches a terminal for carrying out a transaction altering a token value stored in an IC card via an on-line transaction session at a remote terminal. Transaction messages are passed through a data link between the IC card and the remote terminal, relying on the IC card and the remote terminal for message security (column 2, lines 23-35). Mutual authentication and initiation functions are also performed in Nakamura, however, there is no teaching of a control section connected to a signal transfer line set and validating transfer of a control signal transferred on the signal transfer line set, to permit the transfer of secret data, as Applicant claims. At least by virtue of the aforementioned differences, Applicant's claims 4 and 5 distinguish over Emmott in view of Nakamura. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Regarding claim 13, a control circuit of a portable terminal is connected to a signal transfer line set and validates a control signal on the signal transfer line set output by a system unit to a storage unit, to permit the transfer of secret data. Neither Emmott nor Nakamura teach or suggest at least a control circuit validating a control signal on the signal transfer line set to

permit the transfer of the secret data, as discussed above. At least by virtue of the aforementioned differences, Applicant's claim 13 distinguishes over Emmott in view of Nakamura. Applicant's claims 14 and 17-19 are dependent claims including all of the limitations of independent claim 13, which, as established above, distinguishes over Emmott in view of Nakamura. Therefore, claims 14 and 17-19 are distinguished over Emmott in view of Nakamura for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

With further regard to claim 17, claim 17 recites that the control section comprises a switch section which generates a valid signal in response to operation of the switch section by a user, and a control circuit which operates to permit transfer of the control signal in response to the valid signal such that the transfer of the secret data is permitted. There is no teaching or suggestion in Emmott of a control section as Applicant claims. Emmott's switch (25) does not generate a valid signal, nor does any control circuit in Emmott permit transfer of a control signal in response to the valid signal to thus permit transfer of secret data. Therefore, at least by virtue of these additional differences as well as the aforementioned differences, Applicant's claimed invention distinguishes over Emmott.

Regarding claims 21 and 22, which are dependent on independent claim 20, Emmott fails to teach or suggest at least a control circuit operating to permit transfer of a control signal in response to a valid signal such that transfer of secret data is permitted, as discussed above. Nakamura does not remedy the deficiencies on Emmott. There is also no teaching in Nakamura

AMENDMENT UNDER 37 UNDER C.F.R. § 1.116
U.S. Application No. 09/810,220
Attorney Docket No. Q63638

of a control circuit operating to permit transfer of a control signal from a system unit to a storage device in response to a valid signal, such that transfer of secret data from the storage device to the system unit is permitted, as Applicant claims. At least by virtue of the aforementioned differences, Applicant's claims 21 and 22 distinguish over Emmott in view of Nakamura. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Rejection Under 35 U.S.C. § 103(a) - Emmott et al. in view of Nakamura et al. and further in view of Tetro et al.

Claims 6, 7, 15, 16, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Emmott in view of Nakamura and further in view of Tetro et al. (U.S. Patent Number 6,095,413, "Tetro"). The rejection is respectfully traversed.

Regarding claims 6 and 7, Emmott fails to teach or suggest a control section validating transfer of a control signal to permit the transfer of secret data. Nakamura and Tetro do not remedy the deficiencies of Emmott. Nakamura discloses a terminal for carrying out a transaction altering a token value stored in an IC card via an on-line transaction session at a remote terminal, as described above. Tetro discloses the authorizing of electronic credit card transactions and measures for detecting fraudulent transactions. However, there is no mention in either Nakamura or Tetro of a control section/circuit validating transfer of a control signal to permit the transfer of secret data. At least by virtue of the aforementioned differences, Applicant's claims 6 and 7 distinguish over Emmott in view of Nakamura and further in view of Tetro.

AMENDMENT UNDER 37 UNDER C.F.R. § 1.116
U.S. Application No. 09/810,220
Attorney Docket No. Q63638

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Regarding claims 23 and 24, Emmott fails to teach or suggest a control circuit operating to permit transfer of a control signal to such that transfer of secret data from a storage device to a system unit is permitted. Nakamura and Tetro do not remedy the deficiencies of Emmott. Nakamura discloses a terminal for carrying out a transaction altering a token value stored in an IC card via an on-line transaction session at a remote terminal, as described above. Tetro discloses the authorizing of electronic credit card transactions and measures for detecting fraudulent transactions. However, there is no mention in either Nakamura or Tetro of a control section/circuit validating transfer of a control signal to permit the transfer of secret data. At least by virtue of the aforementioned differences, Applicant's claims 23 and 24 distinguish over Emmott in view of Nakamura and further in view of Tetro. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Regarding claims 15 and 16, Emmott in view of Nakamura fail to teach or suggest a control circuit validating a control signal on the signal transfer line set to permit the transfer of secret data, as discussed above. Tetro does not remedy the deficiencies of Emmott and Nakamura. There is no mention in Tetro of a control circuit validating a control signal on the signal transfer line set to permit the transfer of secret data, as also discussed above. At least by virtue of the aforementioned differences, Applicant's claims 15 and 16 distinguish over Emmott in view of Nakamura and further in view of Tetro. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Rejection Under 35 U.S.C. § 103(a) - Emmott et al.

Claim 12 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Emmott. The rejection is respectfully traversed.

Emmott fails to teach or suggest at least a control section validating transfer of a control signal on the data bus to permit the transfer of the encrypted information, as recited in claim 1. Claim 12 is a dependent claim including all of the limitations of independent claim 1, which established above, distinguishes over Emmott. Furthermore, there is no teaching or suggestion in Emmott of a control section validating transfer of a control signal on the data bus to permit the transfer of the encrypted information. Therefore, claim 12 is distinguished over Emmott for at least the aforementioned reasons as well as for its additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Newly Added Claims

Claims 26-28 are newly added by this Amendment and are believed to be in condition for allowance¹. Claims 26-28 are allowable based on at least their dependencies, as well as for their additionally recited features. That is, the cited references do not teach or suggest that access of a storage device by a system unit is only allowed when a user validates transfer of a control signal by operating a switch in the control section, as recited in newly added claims 26 and 27, or that access of a storage device by a system unit is only allowed when a user permits transfer of a control signal by operating a switch section to generate a valid signal, as recited in newly added claim 28.

¹ Support for these claims is found in the specification on at least page 19, line 19 to page 20, line 2.

AMENDMENT UNDER 37 UNDER C.F.R. § 1.116
U.S. Application No. 09/810,220
Attorney Docket No. Q63638

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Lenny R. Jiang
Registration No. 52,432

Date: May 20, 2005